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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,215	02/17/2000	Shimada Naohiro	P/126-182	7056
7590	09/14/2004		EXAMINER	
STEVEN I. WEISBURD, ESQ. DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 1177 AVENUE OF THE AMERICAS - 41st FLOOR NEW YORK, NY 10036-2714			PRIETO, BEATRIZ	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/506,215	NAOHIRO, SHIMADA
	Examiner Prieto B	Art Unit 2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 19 August 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,2,15 and 16 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-2 and 15-16 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____



SUPPLEMENTAL DETAILED ACTION

1. This communication is in response to applicant telephonic communication on 08/19/04 indicating an inter-communication error between the Office actions mailed and applicant's response to these actions.
2. Applicant submitted an amendment/RCE on 02/06/04 (see attached receipt/stamp date), which was replied by office action mailed 03/31/04. Applicant subsequently submitted a response to this office action mailed 05/28/04 (see attached receipt/stamp date) which was inadvertently entered as 03/28/04 as an amendment crossed in mail (see attached application's content log), causing examiner to issue a subsequent office action mailed 08/05/04 in response to this amendment and further vacating previous mailed action 03/31/04.
3. Hence, office has replied to both applicant's communications submitted on 02/06/04 through office action mailed 03/31/04 and applicant's response communication mailed **05/28/04** (logged erroneously as **03/28/04**) through office action mailed 08/05/04.
4. This supplemental **reinstates** office action mailed 03/31/04 in response to amendment/RCE mailed 02/06/04, which was vacated, by office action mailed 08/05/04.
5. No undue burden is believed to be set upon applicant since all these actions are non-final and period for response has been restarted on each instance, never the less the office apologizes for the inconvenience and any delay in the prosecution of instant application this may cause.
6. Hence, this communication is in response to amendment/request for continued examination (RCE) under 37 CFR 1.114 of the above identified application filed 2/06/04. Claims 1-2 and 15-16 remain pending and are hereby presented for examination.
7. The following is a quotation of the first paragraph of 35 U.S.C. 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In this case, the specification and Figs. 4-5 and 2 have been reviewed, however no supporting evidence to added claim limitation “a first layer being the lowest in the layering, a second layer being higher than said first layer and lower than said third layer in said layering” has been found.

Claim Rejections - 35 USC § 103

9. Quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action may be found in previous office action.

10. Claims 1-2 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kudo U.S. Patent No. 6,256,326 in view of Ellis et. al. (Ellis) in view of 6,256,292 U.S. Patent No. 6,256,292.

Regarding claim 1, Kudo teaches claimed invention substantially as claimed, teaching a node(s) (4 and 6 of Fig. 9, col 6/lines 6-21) comprising layers (Fig. 6) including:

a first layer (layers HPT through PPI of Fig. 6), a second layer (layers MSA of Fig. 6) and a third layer (layers MSP to SPI of Figure 6);

a packet is processed (“mapped”) in said first layer (Fig. 6, step b1, col 6/lines 60-col 7/line 3 and col 19/lines 42-50);

said first layer determines whether the packet is to be transmitted to another identified node via an established data link (col 6/lines 39-45, col 8/lines 17-22, transmission to the next node or adjacent node col 22/lines 17-26) and transmitting data (packet) to said third layer through said second layer when determine that the packet is to be forwarded to another node (Fig. 12, col 8/lines 4-15, 33-42);

although prior art teaches determining whether the packet is to be hopped to a next node, it does not explicitly teach, where it determines is the packet is to be dropped at said node;

Ellis teaches a system method related to transmission apparatuses and method in a communication network, wherein that line terminal equipment (LTE) (e.g. add-drop multiplexer ADM) operate in the physical layer (first layer, path and/or line sublayer) (Fig. 1) configured with means for

accessing accesses signals that need to be dropped or inserted at that site, the rest of the traffic continuing straight through (col 7/lines 39-48, Fig. 2B, element 350).

It would have been obvious to one ordinary skilled in the art at the time the invention was made to include the teaches of Ellis for judging at the first layer whether the packet is to be dropped to said node or hopped to a next node, one ordinary skilled in the art would be motivated to utilize the logical (configurable software modules) layers associated with SONET model including transmission path, multiplex section and regeneration sections as suggest by Kudo, allowing a straight path through between two consecutive line terminal equipment and taught by Ellis.

Regarding claim 2, the first layer transmits (Kudo: Fig. 12, marked as A, col 8/lines 4-15, 33-42, Ellis: col 7/lines 21-25,64-65).

Regarding claims 15-16, these claims are the method claims associated with claims 1-2, same rationale of rejection is applicable.

Response to arguments

11. It is argued that layers one through three are *well known in the art*, because these are defined layers of the OSI model. According to applicant, it is readily understood from invention's Figs. 4-5 and 2 that the layers herein illustrated are the layers of the OSI model.

In response to the above-mentioned argument, applicant's remarks have been fully considered, the specification have been reviewed in search of descriptive disclosure that ma support applicant's remarks, however, it is noted that it is not found in the specification where is the OSI model mentioned, or discussed. Figs. 4-5 of the invention illustrated a 1st layer above or higher than a 2nd layer. It is note found where in the OSI model is a 1st layer above or higher than a 2nd layer defined, the OSI model does not define a 1st layer higher than a 2nd layer and 3erd layer. It is note found where in the OSI model is a 1st layer defined as comprising termination of SOH, LOH and POH as illustrated on Fig. 5. The incorporation of *well-known subject matter* in the claims, does not make the claims patentable. Furthermore, a "Well know admittance statement", in which applicant admits on the record that the subject matter in relation to the amended limitation, i.e. "a first layer being the lowest in the layering, second later being higher than said first layer and lower than said third layer in said layering", is well know in the art, and therefore the techniques for implementation and/or enablement, are readily recognize by one ordinary skill in the art. Is taken as being available as prior art against the claims see MPEP

§2129, and 1.131. Therefore, the limitation's elements will be construed as encompassing any and every art-recognized hardware or combination of hardware and software technique for implementing the defined requisite functionalities. Thereby, claim 1 is not distinguishable over the prior art and not patentable. Claim 15 is a method claim corresponding to claim 1 as indicated by applicant, and thereby not patentable for the same reasons.

12. Applicant indicates that amendment to the claim language is explicitly disclosed in the specification, specifically, in the Figures 4-5 and 2, wherein the first layer is the lowest layer in the layering, thereby the terms of the claims must be read in view of the specification.

In response to the above-mentioned argument, it is noted that disclosure has been reviewed, however it is not found where in the specification is the OSI model mentioned. Figs. 4-5 of the invention illustrated a 1st layer above or higher than a 2nd layer. Attention is made to Figure 2, which does not illustrate a first layer or a second for that matter. It is not found where in the OSI model is the layering illustrated in Figs. 4-5 defined, the OSI model does not define a 1st layer above or higher than a 2nd layer and 3rd layer. See supplemental advisory (11/12/03) for definition of the layers as set forth by the invention's specification.

13. Applicant's arguments filed 02/06/04 have been fully considered but not rendered persuasive.

14. Applicant is reminded that in accordance with 37 CFR 1.530 (e) Status of claims and support for claim changes. Whenever there is an amendment to the claims pursuant to paragraph (d) of this section, there MUST also be supplied, on pages separate from the pages containing the changes, the status (i.e., pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper (see MPEP 2234).

Art Unit: 2142

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (703) 305-0750. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Jack B. Harvey can be reached on (703) 305-9705. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained fro the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free)).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to the Central Fax Office:

(703) 872-9306, for Official communications and entry;

Or Telephone:

(703) 306-5631 for TC 2100 Customer Service Office.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Fourth Floor (Receptionist), further ensuring that a receipt is provided stamped "TC 2100".



B. Prieto
TC 2100
Patent Examiner
September 6, 2004